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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,005	12/02/2003	Baruch Segal	3116/1	3160

7590 05/03/2007  
DR. MARK FRIEDMAN LTD.  
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Discovery Dispatch  
9003 Florin Way  
Upper Marlboro, MD 20772

EXAMINER
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STULII, VERA

ART UNIT	PAPER NUMBER
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1761

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/725,005

Applicant(s)

SEGAL ET AL.

Examiner

Vera Stulii

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "desired" in claim 1 is a relative term which renders the claim indefinite. The term "desired" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear as to what defines the weight level that is being desirable. Any weight level may be considered desired.

The term "required" in claim 10 is a relative term which renders the claim indefinite. The term "required" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear as to what defines the required weight level.

### ***Response to Arguments***

Applicants' arguments filed February 11, 2007 have been fully considered but they are not persuasive. In regard to Applicants' arguments, see p.5 of the Reply to the Office Action, filed February 11, 2007, with respect to the rejection(s) of claim(s) 1-23

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under 35 USC § 112 second paragraph, it is noted that the claims have been amended, but still recite relative terms that render the claims indefinite.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Slack (US 5,711,164). The rejection and reference are incorporated as cited in the previous office action.

***Response to Arguments***

Applicants' arguments filed February 11, 2007 have been fully considered but they are not persuasive. In regard to Applicants' arguments with respect to the rejection of claims 1 and 2 under 35 USC § 102(b) (p.6 of the Reply), it is noted that newly added limitation about spatially organized foods in levels is taught by Slack (US 5,711,164) as well. Slack discloses arrangement of foods in levels, and foods in levels appear to be of the similar carbohydrate level (see Abstract figure).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bangs et al (US 6,039,989). The rejection and reference are incorporated as cited in the previous office action.

***Response to Arguments***

Applicants' arguments filed February 11, 2007 have been fully considered but they are not persuasive. In regard to Applicants' arguments with respect to the rejection of claims 1-23 under 35 USC § 103(a) that there is no teaching of spatial food arrangement according to their carbohydrate level in Bangs et al (pp. 7-8 of the Reply), it is noted that Bangs et al do not teach spatial arrangement of foods. However, Applicants did not provide any criticality of specific spatial arrangement. Food items may be arranged by size, packaging, storage temperature, serving temperature, color, order of consumption, etc. Furthermore, the intent behind applicant's claimed composition does not impart patentability to the composition itself. Moreover, there is no mention of specific arrangement, let alone criticality, therefore Applicants' broadly recited claims would not be patentable over the prior art. Applicants have not demonstrated the criticality of this limitation. The claims do not specify that specific foods should be placed in certain places, thus the spatial arrangement of foods that has no specific functionality cannot be relied upon to patentably distinguish the claimed invention from the prior art (See MPEP 2144.04 (I)). Furthermore, the configuration (shape) of the claimed kit is a matter of choice where the person of the ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed kit is significant (See MPEP 2144.04 (IV)). Also, rearranging/shifting foods in the kit would not have modified the operation of the claimed kit.

In response to applicant's argument "it is exactly the shape and configuration of the portable kit and the stacking of foods in levels that are the essential inventive

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features of the independent claims of the present invention" (p.7 of the Reply), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that "[a]ny configuration that does not stack foods by levels of substantially similar carbohydrate content would directly contradict the purposes of the present invention, and would lead to totally undesirable results in terms of the diet regimen" (p.8 of the Reply), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim, regardless of purpose.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vera Stulii *V. Stulii*

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**